

App. No. 10/826,990  
Attorney Docket No. 3053.2.1 NP

**Amendments to the Drawings**

None

App. No. 10/826,990  
Attorney Docket No. 3053.2.1 NP

## Remarks

Applicant thanks the Examiner for the Written Office Action.

With regard to the substantive portion of the Written Office Action, Claims 1-6 and 21-26 were rejected under 35 U.S.C. 112 for failing to comply with the written description requirement; Claims 5-6, 21, 24-25 were rejected under 35 U.S.C. 112 as being indefinite; Claims 1-6 were rejected under 35 U.S.C. 102 as being anticipated by Scott (US 5,268,137); Claims 1-6 were additionally rejected under 35 U.S.C. 103 as being unpatentable over Groves (US 5,647,154) in view of Bryant (US 2004/0035063); Claims 7, 9, and 11 were rejected under 35 U.S.C. 103 as being unpatentable over Bryant in view of Poole (US 6,484,455); Claims 10 was rejected under 35 U.S.C. 103 as being unpatentable over Bryant in view of Poole (US 6,484,455) in further view of Rygiel (US 6,237,294); Claims 21-22 were rejected under 35 U.S.C. 103 as being unpatentable over Kemerer (US 4,290,248); and finally, Claims 23-25 were rejected under 35 U.S.C. 103 as being unpatentable over Kemerer in view of Glover (US 6,612,091).

In response to the Office Action, the Applicant has amended Claims 1, 5, 6, 7, 21, 24-25 to further distinguish the Applicant's invention over the cited references. Specifically, Claim 1 now includes "wherein after molding, the liner is sized and cut to..." Support for this amendment may be found in 32-34. Additionally, Claim 7 now includes "being secured directly to the inside surface of a window well shield without an intermediate mold." Claim 7 further includes wherein the liner is adaptable to a variety of window well shields. The Applicant believes the above amendment does not constitute new matter as this is clearly shown and described in Figures 2 and 5. The adaptability of the liner is described in paragraphs 32-34, as the specification describes measuring out

App. No. 10/826,990

Attorney Docket No. 3053.2.1 NP

the window well and fitting the liner to match the dimensions of the window well.

Indeed, one skilled in the art would realize this as adapting the liner to a variety of window well shields. Additionally, Claims 5-6, 21, and 24-25 now include "adapted to" or functional language, thereby overcoming the indefinite, 112, rejection.

#### **Response to 112 Rejections**

In regards to the 35 U.S.C. 112 rejections the Applicant respectfully disagrees the inclusion of language "liner consisting essentially of" fails to comply with the written description requirement and would be considered new matter not previously disclosed. Indeed, "consisting essentially of" defines the scope of the claim to those elements or steps in the claim and those that do not materially affect the basic and novel characteristics of the claimed invention. (See MPEP §2111.03) Further, an applicant may amend the claims to include "consisting essentially of" provided the additional materials and/or steps recited in the prior art would materially change the characteristics of the Applicant's invention. See MPEP §2111.03 and *PPG Industries Inc. v. Guardian Industries Corp.*, 156 F.3d 1351, 1355, 48 USPQ2d 1351, 1355 (Fed. Cir. 1998).

In this case, the Applicant's inclusion of "consisting essentially of" excludes teachings of Scott and distinguishes the Applicant's invention from Scott. The additionally disclosures and/or teachings recited in Scott, would clearly material change the characteristics of the Applicant's invention. The purpose, structure and function of the liner as taught in Scott is vastly different from that of the Applicant invention. First, the purpose in Scott is in creating the appearance of a brick structure on newly poured and wet concrete/cement. Additionally, as taught in Scott, the liner is a mold, made to be temporary placed there and peeled off when finished.

App. No. 10/826,990

Attorney Docket No. 3053.2.1 NP

In contrast, the Applicant's invention teaches and is directed toward a permanent/semi-permanent covering whose purpose is not to mold the structure the liner is place against, but rather to be fixed there. Indeed, the additional steps disclosed in Scott, such as peeling away and molding wet cement, would impede the purpose of the Applicant's invention. The purpose of the Applicant's invention is to leave the liner in place and not to peel it off or mold the window well.

Additionally, even though the Applicant's specification does not specifically disclose the terms "consisting essentially of", it is still not new matter because all of the included limitations are present and discussed in the Applicant's specification. Indeed, "consisting essentially of" is transitional phrase which is a synonym for "including". Indeed, one skilled in the art would realize that the limitations and/or elements of the consisting essentially of claims as described in the Applicant's specification could be limited to only those elements. Accordingly, the Applicant submits that the inclusion of consisting essentially is proper and should be given proper weight.

#### **Response to 102 Rejections**

In response to the 35 U.S.C. rejection, the Applicant contends that because of the above arguments with the respect to the "consisting essentially of" additions the Applicant's invention is sufficiently distinguished over Scott. Indeed, Scott, while including those limitations taught by the Applicant's invention, Scott does teach additional limitations, elements which would materially affect the Applicant's invention, as described above.

App. No. 10/826,990  
Attorney Docket No. 3053.2.1 NP

### Response to 103 Rejections

The Applicant believes the claims as amended sufficiently distinguish the Applicant's invention from the cited references. Specifically, the Applicant has amended Claim 1 to include "wherein after molding, the liner is sized and cut..." As described in the Applicant's specification, the Applicant's liner is molded and then sized to fit the dimensions of a window well (see paragraphs 32-34). This unique features enables a user to produce a plurality of molded liners, and then subsequently have those liner sized and cut to windows wells with a variety of shapes and sizes. In contrast, in Bryant, each molded material must be molded to meet the sizes and dimensions of each window well wherein the mold material is applied (see Fig. 4, paragraphs 24-25). Therefore, each mold/liner must be made specific to the particular dimensions of a window well. Whereas, as described previously, as taught in the Applicant's claims, a user may produce a plurality of liners and then cut them to fit a plurality of types and sizes of window wells.

Additionally, the Applicant has amended Claim 7 to include "a single sheet window well liner secured directly to an inside surface of a window well shield without an intermediate mold." This further shown and described in the Applicant's specification in Figures 2 and 5, the window well 102 directly attached to the liner 100. While Bryant does teach attaching a molded material to a window well, as taught in Bryant, an intermediate layer/mold is required. As taught in Bryant there is a liner or molded material 106 attached to a substrate 114, which is then attached to the window well 104 (Figures 1, 2, paragraphs 21-22).

App. No. 10/826,990  
Attorney Docket No. 3053.2.1 NP

*Combination of Bryant and Groves improper in rejecting Claim 1-6*

The Applicant respectfully disagrees with the Examiner's combination of Bryant and Groves due to the references teaching away from any potential combination, in addition to impossibility and impracticality. Indeed, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). First, Groves teaches that the liner may be rolled up and placed in a cylindrical tube for easy transport and/or installation. Indeed, this is one of the unique features claimed in the invention and is taught throughout the Groves specification (fig. 9, col. 4 lines 10-14; col. 2, lines 1-6, claim 6). The disclosure in Groves teaches away from Bryant, because as the molded material is described in Bryant, it would be near impossible and impractical to roll the molded material into a cylindrical tube. Specifically, the molded material in Bryant includes three dimensional projections such as artificial rocks, contoured bumps (Figure 2, items 110, 112; paragraph 20). The molded material in Bryant additionally includes "molded egress steps" which allow for a person to climb in and out of the window well (Figure 2, items 206, 208; paragraph 22). Attempting roll and store the Bryant material would prove futile, as the egress steps and the contoured bumps extending outward from the material would be symmetrically lined against each other causing the rolled material to be extremely bulky and unstable.

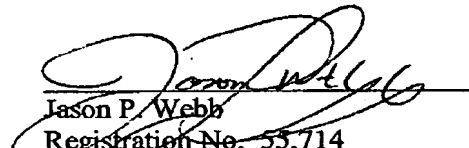
The combination of Bryant and Groves is further improper in light of the Court's recent decision in *KSR v. Teleflex*, No. 04-1350, 14 (U.S. Apr. 30, 2007), wherein in formulating a 103 (a) rejection, there must be an apparent reason to combine known

App. No. 10/826,990  
Attorney Docket No. 3053.2.1 NP

elements, and the analysis combining such should be made explicit. In this case, the Examiner cited the reason for combining as simply providing a decorative rock pattern to suit a consumer's design performance and failed to explicitly state reasons for the combining

For these reasons, it is believed that none of the prior art teaches the claimed invention. Furthermore, it is believed that the foregoing amendment has adequate support in the specification, and accordingly there should be no new matter. Applicant believes the pending claims have addressed each of the issues pointed out by the Examiner in the Office Action. In light of the foregoing amendments and remarks, the claims should be in a condition for allowance. Should the Examiner wish to discuss any of the proposed changes, Applicant again invites the Examiner to do so by telephone conference.

Respectfully Submitted,

  
Jason P. Webb  
Registration No. 55,714  
Attorney for Applicant

Date: May 7, 2007

Jason P. Webb  
Advantia Law Group  
Starkweather and Associates  
9035 South 1300 East  
Suite 200  
Sandy, Utah 84094  
Telephone: 801/272-8368